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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,460	05/31/2001	Frank McConville	4967	9809

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EXAMINER

CHORBAJI, MONZER R

ART UNIT	PAPER NUMBER
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1744

DATE MAILED: 03/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/871,460

Applicant(s)

MCCONVILLE ET AL.

Examiner

MONZER R CHORBAJI

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 02/20/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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4. Claims 1-4, 6, and 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swidler (U.S.P.N. 6,124,044) in view of Schneberger et al (U.S.P.N. 5,736,470).

With respect to claims 1, 6, 11, and 14, Swidler discloses a method and a composite for inhibiting corrosion (abstract, lines 1-10) including depositing a layer of fragile (in the beginning, the layer is fragile by being a liquid then over time it hardens) corrosion inhibiting material (col.4, line 30 and col.5, lines 31-33) whose bottom layer includes an adhesive film (since the substrate adheres to the surface of the car) in contact with the article, and applying the transferable substrate (the substrate is peelable and can be transferred away from the article), which is made up of the corrosion inhibiting layer and the adhesive layer to the article (col2, lines 16-19). Also, Swidler teaches of applying the composite to the brake rotors (col.6, lines 64-67 and col.7, lines 1-2) and of separating the composite from the surface of the article (col.6, lines 34-36). Furthermore, Swidler teaches that it is known to deposit layers onto the surface of a car to protect it from the environment (col.1, lines 39-46). However, fails to teach depositing a layer of corrosion inhibiting film onto a carrier film and separating the carrier film from the transferable substrate. With respect to claims 1, 6, 11, and 14, Schneberger et al, which is in the art of applying protective laminates to cars (figure 1, 10 and col.6, lines 42-45) discloses depositing a protective layer (intrinsically acts as an anticorrosive film against the environment (figure 2, 12) onto a carrier film (figure 2, 18) and separating the carrier film (col.5, lines 33-39) from the transferable substrate (figure 2, 12 and 14). Thus, it would have been obvious to one having ordinary skill in the art to

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modify the method and composition of Swidler to include a carrier film in order to add additional functional chemical compounds to such a film (Schneberger et al, col.5, lines 39-40).

With respect to claims 2-3, Swidler discloses such thickness ranges (col.6, lines 8-10).

With respect to claim 4, since Swidler applies the transferable substrate to brake disc rotors then it is believable that such a substrate is in the shape of disc rotors (col.6, lines 64-67 and col.7, lines 1-2).

With respect to claims 9-10 and 12-13, Swidler teaches the following: depositing the adhesive layer on the anticorrosion layer prior to applying the corrosion inhibiting material to the article (abstract, lines 4-10) such that the bond between the corrosion inhibiting material and the article is greater than the bond of the corrosion inhibiting material and the carrier film (col.2, lines 44-46), and applying an adhesive material to the frangible corrosion material prior to (abstract, lines 5-7) transfer of the carrier substrate to the receiving surface (col.2, lines 40-43).

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swidler (U.S.P.N. 6,124,044) in view of Schneberger et al (U.S.P.N. 5,736,470) and further in view of Mertens et al (U.S.P.N. 6,268,032).

With respect to claim 5, both Swidler and Schneberger et al fail to teach specifically such a material in the corrosion inhibiting film. However, Mertens et al teaches the use of Daubert VCI material (col.14, lines 50-52). Thus, it would have been obvious to one having ordinary skill in the art to modify the method of Swidler to include

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Daubert VCI material depending on whether the laminate is transparent, translucent, opaque, or a combination thereof (Mertens et al, col.14, lines 46-48).

6. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swidler (U.S.P.N. 6,124,044) in view of Schneberger et al (U.S.P.N. 5,736,470) and further in view of Haberstroh et al (U.S.P.N. 4,071,391).

With respect to claims 7-8, both Swidler and Schneberger et al fail to teach such a specific material. However, Haberstroh et al teaches the use of polyethylene acrylic acid copolymers (col.2, lines 30-32). Thus, it would have been obvious to one having ordinary skill in the art to modify the method of Swidler to include polyethylene acrylic acid copolymers since it is known that lead may be bonded with such a material without requiring any adhesives (Haberstroh et al, col.1, lines 13-16).

### **Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MONZER R CHORBAJI whose telephone number is (571) 272-1271. The examiner can normally be reached on M-F 8:30-5:00.

8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ROBERT J WARDEN can be reached on (571) 272-1281. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Monzer R. Chorbaji *MRC*  
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02/20/2004

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